

REMARKS

The indication of allowable subject matter in claims 2, 5 and 8-15 is acknowledged and appreciated. For the following reasons, it is respectfully submitted that all claims are in condition for allowance.

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Oikawa et al. ("Oikawa") in view of Frederiksen '357 ("Frederiksen"), and claims 3, 4, 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Oikawa in view of Frederiksen and Omoya et al. '996. Claim 1 is independent. These rejections are respectfully traversed for the following reasons. In particular, it is respectfully submitted that even assuming *arguendo* proper, the proposed combination does not disclose the claimed invention.

The Examiner admits that Oikawa does not teach an optical fiber fixed to a face of a light-receiving photo-semiconductor device. As shown in Figure 1 and more clearly in Figure 7 of Oikawa, the optical fiber is not fixed to the photodiode. The Examiner therefore relies on Frederiksen as allegedly disclosing fixing a light pipe 12 "to the face of the light receiving semiconductor device 18" and attempts to modify Oikawa to reach the claimed invention. However, it is respectfully submitted that Frederiksen is merely cumulative to Oikawa and has the same deficiency thereof. That is, Frederiksen does not disclose fixing the light pipe 12 to the face of the light receiving semiconductor device 18 as relied on by the Examiner. In contrast, the light pipe 12 is expressly disclosed as being spaced away from the alleged light receiving semiconductor device 18 (*see* col. 3, lines 51-53 corresponding to Figure 1; which states that "[s]eparation of the end of the light pipe 12 and the active photo-responsive device 18 is shown by reference numeral 18A").

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Furthermore, each of the withdrawn independent claims 16 and 19 recites in pertinent part, "fixing an optical fiber to said back face" and are therefore submitted to be patentable for at least reasons similar to those discussed above regarding the elected claims. Accordingly, Applicants respectfully request that the Examiner rejoin the withdrawn claims in order to consolidate Applicants' application.

Based on all the foregoing, it is submitted that claims 1-21 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY


Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 RMF:mcm
Facsimile: (202) 756-8087
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